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said insulating member being disposed between said membrane spring and said first portion of said pressure plate;

said second portion of said pressure plate being disposed to contact said membrane spring;

said insulating member being rigid and comprising a metal;

said metal of said insulating member being configured to minimize heat conduction from said first portion of said pressure plate to said membrane spring to minimize distortion of said membrane spring from thermal conduction of heat from said pressure plate to said membrane spring.

REMARKS

Claim 8 has been amended by adding language that is substantially identical to lines 40-47 of original claim 4 and which was inadvertently omitted in the reissue claim. No new matter has been added.

Claims 5-8 stand rejected under 35 U.S.C. § 251 as being improper recapture of claimed subject matter deliberately cancelled in the application for the patent upon which the present reissue is based. The rejection is respectfully traversed.

The Examiner specifically quotes *Ball Corp. v. United States*, 221 U.S.P.Q. 289, 295 (Fed. Cir. 1984): "The recapture rule bars the patentee from acquiring, through a reissue, claims that are of the same or broader scope than those claims that were cancelled from the original application.

However, immediately following the statement quoted by the Examiner, the Court of Appeals for the Federal Circuit continues:

On the other hand, the patentee is free to acquire, through reissue, claims that are *narrower* in scope than the cancelled claims.

In *Ball Corp.*, as well as in the instant reissue application, the recapture rule was avoided because the reissue claims were sufficiently narrowed despite the broadened aspects of the claims. 221 U.S.P.Q. at 296.

Thus, it is clear that the recapture rule may be avoided in circumstances where the reissue claims were materially narrowed in other respects. See, e.g. *Mentor Corp. v. Colorplast, Inc.*, 27 U.S.P.Q.2d 1521, 1525 ("reissue claims that are broader in certain respects and narrower in others may avoid the affect of the recapture rule."). *In re Clement*, 45 U.S.P.Q.2d 1161, 1165. This principle operates to overcome the recapture rule when the reissue claims are materially narrower in other overlooked aspects of the invention. The purpose of this exception to the recapture rule is to allow the patentee to obtain through a reissue a scope of protection to which he is rightfully entitled for such overlooked aspects. *Hester Industry Inc. v. Stein Inc.*, 46 U.S.P.Q.2d 1616 41, 1649-50 (Fed. Cir. 1998).

The prosecution history of the instant patent demonstrates that the reissue claims were narrowed in a material respect, i.e. in an aspect germane to the prior art rejection. *In re Clement*, 45 U.S.P.Q.2d at 1165.

In the first Office Action dated February 28, 1997 (paper No. 7) claims 1-11 and 13-20 were rejected under 35 U.S.C. § 102(b) as being anticipated by EP application No. 249 469. The Examiner specifically pointed to insulating member 39 in Fig. 4 and its location as shown in the embodiment of Fig. 13.

The rejection of claim 12 under 35 U.S.C. § 103(a) as being obvious over EP application No. 249 469 also focused on the heat insulating member of Fig. 4.

Applicant's amendment (Paper No. 8) added new claims 21-40. In the next Office Action new claims 21, 27, 34 and 35 were rejected under 35 U.S.C. § 103(a) as being obvious over applicant's own U.K. patent No. 1 432 739. Again, the Examiner focused on "hardened balls 4 or pins 5", as being analogous to applicant's claimed insulating member.

The Office Action also indicated that claims 22-26, 28-33 and 36-40 would be allowable if rewritten in independent form.

On July 30, 1997, the Examiner issued a Supplemental Office Action in which the allowability of claim 22-25, 28-30, 32 and 36-39 was withdrawn in view of Japanese reference 55-145726. The rejection was based on 35 U.S.C. § 102(b) and, again, focused on the heat insulating material 29 shown in Figs. 2. The Examiner stated, as it turned out, erroneously, that the insulating material 29 was made of metal ("the heat insulating material 29 is shown by the cross hatching in Figs. 2(A), 2(B), and 2(C) to be metal". (Office Action dated July 30, 1997 at page 2).¹

This Office Action also indicated that claims 26, 31, 33 and 40 would be allowable if rewritten in independent form.

¹ As a later translation showed, member 29 is made from a hard synthetic resin.

Responsive to this Office Action and based on the erroneous understanding of the Japanese reference applicant's attorney simply put the allowable subject matter in independent form.²

As can be seen, the prosecution history focused entirely on the shape, properties and location of the insulating material of applicant's claimed clutch.

It is exactly this aspect of the reissue claims which has been narrowed as compared to the claims allowed in the subject patent. For example, the reissue claims require

- that the insulating member is only in axial contact with the radially extending surface of the membrane spring and
- that the insulating member extends circumferentially about the pressure plate.

These limitations are not present in the allowed claim 1-4 of the subject patent.

Accordingly, the reissue claims are narrower in an aspect that directly relates to the rejections of the original claims so that the recapture doctrine does not apply in this case. Hence, allowance of the reissue claims as presented is respectfully urged.

The Examiner also makes the point that "the narrow scope of the claims in the patent was not an error within the meaning of 35 U.S.C. § 251". It is respectfully submitted that this argument is not well taken. As stated in the declaration "[a]n error being relied upon as a basis for this reissue application is that one or more claims are too narrow and that the attorney handling this case failed to appreciate the full scope of the invention". This form of error has

² However, by electing the allowable subject matter, applicant did not give up or surrender the rejected subject matter. To the contrary, applicant's attorney stated that "applicant

generally been accepted as sufficient to satisfy the "error" requirement of Section 251. See *Clement*, 45 U.S.P.Q.2d at 1163 and *In re Wilder*, 221 U.S.P.Q. 369, 371 (Fed. Cir. 1984). MPEP 1402.

Again, when the reissue claim is narrower than the cancelled claim in a material respect, the presumption - that the claim was cancelled or narrowed based on a deliberate judgment that the claim as originally drafted was unpatentable cannot be made based exclusively on a comparison of the reissue claim with the narrowed claim. This is so because the fact that a particular claim is unpatentable over prior art does not mean that a claim that is narrower in some respect necessarily also would be unpatentable. The addition of a particular limitation can result in an otherwise unpatentable claim becoming patentable. Accordingly, no conclusion as to patentee's intent and, therefore, as to the absence of "error" within the meaning of 35 U.S.C. § 251 can be made. *Patecell v. U.S.*, 12 U.S.P.Q.2d 1440, 1447 (U.S. Cl. Ct. 1989). ["This court concludes that the recapture rule should not bar a patentee from securing a reissue claim that is broader in a material respect than a cancelled claim when, as is potentially the case here the reissue claim also is narrower than the cancelled claim in a way that is material to the error".] Accordingly, applicant's attorney's error is a proper basis to satisfy the "error" requirement of 35 U.S.C. § 251.

Turning now to the art rejections, claims 5, 6 and 8 stand rejected under 35 U.S.C. § 102(a) and (e) as being anticipated by Hayes U.S. Patent No. 5,499,704. This rejection is respectfully traversed. The Examiner states that Hayes discloses, *inter alia*, a thermal insulating member 44, 56 and that the insulating member is supported on the surface of the

retains the right to pursue broader claims under 35 U.S.C. § 120" (amendment dated September 29, 1997 at page 16).

pressure plate and that it extends circumferentially about the pressure plate. It is respectfully submitted that the rejection is not well taken. First, what the Examiner calls "a thermal insulating member 44, 56" are in fact described by Hayes as spherical balls 44 and ball retainer ring 56.

Applicant's claims recite that the thermal insulating member "is only in axial contact with said radially extending surface of said membrane spring". This does not apply to ball retainer ring 56 in Hayes which does not contact the diaphragm spring 30 in Hayes. On the other hand, and although spherical balls 44 are in contact with diaphragm spring 30, they do not extend "circumferentially about said pressure plate" as claimed by applicant. Accordingly, the friction clutch disclosed by Hayes, with its spherical balls 44 does not read on applicant's reissue claims.

Moreover, the Examiner's argument that the "thermal insulating member includes a molded plastic portion" is also not well taken since, as pointed out above, applicant's reissue claims require that the insulating member is in axial contact with the membrane spring, which is not the case with the molded plastic portion of Hayes (ball retainer ring 56). Thus, the ball retainer ring 56 cannot be part of the thermal insulating member as recited in applicant's reissue claims. Accordingly, the thermal insulating member in Hayes can only be the spherical balls 44. Hence, Hayes fails to disclose that the insulating member has a first resistance to thermal conductivity and the membrane spring has a second resistance to thermal conductivity and that the first resistance to thermal conductivity is higher than said second resistance, as recited in applicant's reissue claims. Based on the preceding arguments, it is respectfully submitted that the rejection under 35 U.S.C. § 102 as anticipated by Hayes should be withdrawn.


With respect to claim 6, it is respectfully submitted that the Examiner's argument that "the insulating member of Hayes includes a first surface contacting the membrane spring

and a second surface contracting the pressure plate (see, for example, Figs. 2 and 3)" is also not well taken. As pointed out above, applicant's claims require the insulating member to be in axial contact with the membrane spring. This may apply to spherical balls 44 -- but spherical balls 44 do not comprise a second surface contacting the pressure plate as recited in claim 6. In Hayes, although the ball retainer ring 56 (which, for the reasons set forth above, cannot be the insulating member recited by applicant) is in contact with pressure plate 16, the ball retainer ring 56 is not in contact with the membrane spring as recited in claim 6. Accordingly, the rejection of claims 5 and 6 based on Hayes should be withdrawn and same is hereby respectfully urged.

It is believed that no fees or charges are required at this time in connection with the present application ; however, if any fees or charges are required at this time, they may be charged to our Patent and Trademark Office Deposit Account No. 03-2412.

Respectfully submitted,

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Dated: January 17, 2001